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MAILED

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OFFICE OF PETITIONS

In re Patent No. 6,228,074 :
Issue Date: 05/08/2001 :
Application Number: 09/173,422 : **DECISION ON PETITION**
Filing Date: 10/15/1998 :
Attorney Docket Number: 55855.3 :

This is a decision on the petition, filed on May 21, 2012 under 37 CFR 1.378(e), requesting reconsideration of a prior decision which refused to accept under § 1.378(b)¹ the delayed payment of a maintenance fee for the above-referenced patent.

The petition under 37 CFR 1.378(e) is **DENIED**.²

BACKGROUND

The patent issued May 8, 2001. The first maintenance fee was timely paid. The second maintenance fee could have been paid from May 8 through November 10, 2008, or, with a surcharge, during the

¹ A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

² As stated in 37 CFR 1.378(e), no further reconsideration or review of the decision refusing to accept the delayed payment of the maintenance fee under § 1.378(b) will be undertaken. This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1001.02.

period from November 11, 2008, through May 8, 2009. Accordingly, the patent expired at midnight on May 8, 2009, for failure to timely submit the second maintenance fee.

On November 8, 2011, a petition under 37 CFR 1.378(b) was filed. On November 21, 2011, the petition was dismissed. On January 19, 2011, a request under 37 CFR 1.378(e) was filed. On March 21, 2012, a request for information letter was mailed in response. On May 21, 2012, the present renewed request under 37 CFR 1.378(e) was filed.

Petitioner asserts that responsibility for tracking the due dates for the maintenances fees in this patent originally resided with the law firm of Brown Rudnick Berlack Israels LLP ("Brown Rudnick"). Petitioner's registered patent practitioner, John Serio, was associated with Brown Rudnick at the time the patent issued. Petitioner further asserts that attorney Serio subsequently left his association with Brown Rudnick and joined the law firm of Seyfarth Shaw, LLP ("Seyfarth Shaw").

Petitioner, inventor Stephen Almeida, stated that he wished to have attorney Serio continue to handle his patent matters, and sent a request on May 16, 2007, to Brown Rudnick, asking that his patent files be transferred to Seyfarth Shaw.³ However, the patent was not docketed at Seyfarth Shaw for payment of the second maintenance fee, and the maintenance fee was not timely paid.

Petitioner provided, with the first petition, a declaration from June E. Kaps ("Kaps"), docketing administrator for Seyfarth Shaw, statements that both electronic and physical files for the transferred patents were to be sent from Brown Rudnick to Seyfarth Shaw. However, petitioner asserted that neither the physical nor the electronic files for the subject patent were transferred from Brown Rudnick to Seyfarth Shaw, and, as a result, the patent was not docketed for payment of the second maintenance fee.⁴

In the decision mailed on November 21, 2011, petitioner was requested to provide evidence that a reliable system was in place for transferring the data.

³ Petition filed on November 8, 2011, Exhibit A.

⁴ Kaps declaration, Petition filed on November 8, 2011, Exhibit B, Paragraph 22.

In response, on January 19, 2012, a renewed petition was filed, accompanied by, *inter alia*, additional declarations to explain the system for transferring the data.

On March 21, 2012, a Request for Information was mailed, requesting affidavits from docketing personnel Deborah Hopkins and Betty McCorkle as well as any CPI personnel involved in transferring the files.

In the subject renewed petition, petitioner states that Ms. McCorkle, who is no longer employed by Brown Rudnick, "only assisted in a secretarial role and did not assist in the systems and procedures for the Transfer." Petitioners further state that "Despite diligent effort by [Mark] Leonardo (partner at Brown Rudnick), Hopkins being no longer employed by Brown Rudnick and for her own reasons could not timely cooperate in executing a Declaration regarding the facts of the Transfer." Petitioner further states that "the requested Declaration of Deborah Hopkins would not add to the record, as she oversaw the high level operation of the file room and did not engage in the day to day activities, such as the Transfer."

Petitioner further provided a supplemental declaration of June Kaps, the former docket administrator at Brown Rudnick and currently a docket administrator for Seyfarth Shaw, attesting to the reliability of the docketing system at Brown Rudnick.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required subsection (b) of this section which is made within twenty-four months after the six-month grace period if this delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 CFR 1.378(b)(3) states that any petition to accept an unavoidably delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the

maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

37 CFR 1.378(c)(3)(1) provides that a petition to accept an unintentionally delayed payment of a maintenance fee must be filed within twenty-four months of the six-month grace period provided in § 1.362(e).

OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".⁵ A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."⁶ This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."⁷ Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.⁸ Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.⁹ However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.¹⁰ In

⁵ 35 U.S.C. § 41(c)(1).

⁶ *Ray v. Lehman*, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

⁷ *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁸ *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

⁹ *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

¹⁰ *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

view of In re Patent No. 4,409,763,¹¹ this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").¹² Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.¹³ In this regard:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.¹⁴

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. §

¹¹ 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

¹² Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

¹³ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

¹⁴ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.¹⁵ That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.¹⁶

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.¹⁷ Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.¹⁸

Petitioner has failed to show that the delay in payment of the second maintenance fee was unavoidable.

Petitioner asserts, in essence, that a clerical error resulted in the failure of the transfer of information for the subject patent from the Brown Rudnick docketing system to the Seyfarth Shaw docketing system. Petitioner states, in pertinent part:

As Petitioner has previously established, it is respectfully submitted that Seyfarth Shaw also did not receive the client requested physical files as established by the previously submitted declarations of Serio, Kaps and Colon. The file transfer protocol in place that was developed by experienced patent practitioners and Kaps, an experienced patent docketing clerk with over 17 years of experience, was dependant (sic) upon the receipt of at least a physical file and/or its corresponding electronic docketing information.

In developing Seyfarth's file transfer protocol, redundant transfer of both physical and electronic docketing information was aimed at ensuring that

¹⁵ Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

¹⁶ Id.

¹⁷ Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960) (35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing).

¹⁸ See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd* 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, *supra*.

transfer errors would be reasonably avoided, however, since it was dependent (sic) upon humans, no protocol would be absolutely fail safe and therefore some errors are "unavoidable," as is acknowledge by the Patent Office in providing for the within petition rights. The file transfer protocol developed by Seyfarth was reasonably based upon a system that accounted for failures in transfer of either the physical file or the docketing information.

(emphasis in original)

Petitioner's argument has been considered, but is not persuasive. A showing of unavoidable delay due to docketing error does not require a showing that a docketing system is "absolutely fail safe" but only that petitioners exercised the level of care of a reasonably prudent person acting with respect to his or her most important business.¹⁹

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;

(3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.²⁰

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of

¹⁹ See note 9, supra.

²⁰ See MPEP 711.03(c) (III) (C) (2).

the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

With regard to item (1) above, petitioner has not identified the error which was the cause of the delay at issue. There appear to be at least two errors that occurred: (a) the subject patent was not included among the electronic files received at Seyfarth Shaw from CPI because Brown Rudnick mistakenly instructed CPI to transfer only matters containing non-docket information, and (b) the physical files received from Brown Rudnick did not include the subject patent.

The declaration of Keith Schultz, Director of Information Services for Brown Rudnick, filed on January 19, 2012, states, in pertinent part, that:

11. Pursuant to this request we made arrangements to have the Client's physical files transferred. We further made arrangements, in coordination with CPI, to transfer the Client's electronic docket entries on the CPI system to Seyfarth. The transfer of the electronic docket entries apparently only affected a transfer of selected Client files concerning matters 7 and 9 and not all Client matters, as the Client had instructed. During the course of Brown Rudnick's investigation, regarding the circumstances giving rise to the expiration of the Petition Patent, it was determined that the selected electronic files attempted to be transferred, matters 7 and 9, concerned non-patent matters for the Client, which contained no docket information;

12. Despite a diligent investigation, I am unsure why a request for the electronic transfer of docketing information for only selected files was sent to CPI, for the Client...

Petitioner has not explained whether Schultz or another person was responsible for actually making the determination of what information to send, or not to send, to CPI, and ultimately Seyfarth Shaw, or why this decision was made.

Further in this regard, there is no explanation as to why the physical file was not delivered from Brown Rudnick to Seyfarth Shaw.

With regard to item (2) above, petitioner has not shown that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance.

Obviously, if the purpose of the business routine was to transfer files from Brown Rudnick to Seyfarth Shaw, and Brown Rudnick mistakenly told CPI not send the required information concerning this patent to Seyfarth Shaw, the business routine cannot be relied upon to serve its intended purpose, and the delay cannot be considered unavoidable.

Further, the fact that U.S. Patent No. 6,595,986, which was to be transferred from Brown Rudnick to Seyfarth Shaw, had also expired,²¹ casts further doubt on the reliability of the process for transferring patents from Brown Rudnick to Seyfarth Shaw.

Lastly, petitioner has not provided evidence of checks on the described work which were used to assure proper execution of assigned tasks. Petitioner has not stated who reviewed the information at Brown Rudnick used to determine what files were sent, who specifically sent the physical files, or what kind of review was done at Brown Rudnick to ensure that the proper files had in fact been sent.

In this regard, while the declaration of Schutzl states that Deborah Hopkins and Betty McCorkle were involved in the transfer of the files, petitioners assert that McCorkle "only assisted in a secretarial role and did not assist in the systems and procedures for the Transfer" and that obtaining a declaration from Hopkins "would add nothing further to the record." As such, the record simply alleges that an error occurred, but does not explain how the errors occurred, why they occurred, or who was responsible. In the absence of this information, the petition cannot be granted.

²¹ See Kaps declaration, Paragraph 23, attachment D, to petition filed November 8, 2011).

In summary, petitioner has identified neither the source of the error(s) which led to the delay nor its cause, nor explained what steps were in place to avoid the error(s) which led to the delay. In the absence of this information the delay cannot be considered to be unavoidable.


More to the point, the showing of record is that no system was in place for tracking and paying the maintenance fee: This patent was not entered into Seyfarth Shaw's system, and Brown Rudnick had ceased to represent the client. As such, there was no system in place to track and pay the maintenance fee at the time the second maintenance fee was due.

The prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. The petition under § 1.378(c) has also been considered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable, or unintentional, within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b) and (c).

Since this patent will not be reinstated, the maintenance fee(s) and surcharge fee(s) submitted by petitioner will be refunded to counsel's deposit account. The \$400.00 fee for reconsideration will not be refunded, and will be deducted from the amount refunded.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

The patent file is being returned to Files Repository. Telephone inquiries should be directed to Senior Petitions Attorney Douglas I. Wood at 571-272-3231.



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